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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) PGLD-P01-003	
		Application Number 09/835458	Filed April 16, 2001
		First Named Inventor Majid Anwar	
		Art Unit 2674	Examiner J. E. Lesperance

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant /inventor.
- ☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)

☒ attorney or agent of record.

Registration number 54,130

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34.

Signature
Edward A. Gordon
Typed or printed name

(617) 951-7066

Telephone number

June 13, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

I hereby certify that this correspondence is being deposited with the U.S. Postal Service with sufficient postage as First Class Mail, in an envelope addressed to: MS AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Dated: 6/13/06

Signature: Joanne Ryan (Joanne Ryan)



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Dated: 6/13/06 Signature: Joanne Ryan

(Joanne Ryan)

Docket No.: PGLD-P01-003
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Majid Anwar

Application No.: 09/835458

Confirmation No.: 7727

Filed: April 16, 2001

Art Unit: 2674

For: USER INTERFACE SYSTEMS AND
METHODS FOR MANIPULATING AND
VIEWING DIGITAL DOCUMENTS

Examiner: J. E. Lesperance

PRE-APPEAL BRIEF REASONS FOR REVIEW

MS AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Final Office Action (the "Final Action") pending in the above referenced application, Applicant requests a panel review of the pending rejections prior to proceeding with the full appeals process. Applicant encloses the requisite Notice of Appeal along with the remarks set forth below.

The application currently includes 20 pending claims, 1 of which is independent. Independent claim 1 relates to a computing device having a user interface process that identifies user interface commands entered by a user in the form of a command stroke on a touch sensitive display. The interface process compares the shape of a detected input stroke to shapes associated with a plurality of command strokes to identify the command. The identification is independent of the relationship between the location on the display of the input stroke and the location of visible elements on the display. Independent claim 1 and the claims that depend on claim 1 stand rejected over US Patent No. 6,717,573 (hereinafter referred to as "Shahoian") in view of US Patent No. 6,525,749 (hereinafter referred to as "Moran").

For an office action to establish a prima facie case of obviousness against a claim, the prior art reference or references used to form the rejection must teach or suggest all the claim

limitations. In addition there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. MPEP § 2143.

The Non-Final Office Action mailed November 15, 2005 (the “Non-Final Action”) failed to meet these requirements in rejecting independent claim 1. In particular, the Non-Final Action failed to identify any evidence of a motivation or suggestion to combine the references used as the basis of the §103 rejection. The Non-Final Action merely stated “it would have been obvious to a person of ordinary skill in the art at the time the invention was made to utilize the gesture as taught by Moran in the haptic mouse disclosed by Shahoian because this would provide a system including a data interface surface and user controllable means for generating information on said surface.” In *Ex Parte Baldus*, the Board of Patent Appeals and Interferences stated,

“It is not sufficient to make up reasons for motivation, no matter how plausible these explanations may seem in hindsight, without some factual evidence to support those reasons.

Appeal No. 97-0784, 1997 WL 1909601, *3 (Bd.Pat.App. & Interf.). As noted in several Board opinions,

“[E]vidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge or one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved...The range of source available, however, does not diminish the requirement for *actual evidence*.”

(emphasis added). See, e.g., *Ex Parte Franando Valle*, Appeal No. 2005-0394, 2005 WL 951689, *3 (Bd.Pat.App. & Interf.). Applicant specifically identified this shortcoming in the Applicant’s Response to Non-Final Office Action, filed February 15, 2006 (“Applicant’s Response”) stating that the asserted combination was based on impermissible hindsight. See Pages 6–7. The Final Action failed to remedy this deficiency.

In response to Applicant’s remarks regarding the failure of the Non-Final Action to provide evidence of suggestion or motivation to combine the cited references, the Final Action merely states “The applicant has to point out what he/she thinks is allowable in independent claim 1 that the prior art does not teach.” This statement is counter to the law and to the MPEP. As stated in MPEP § 2142, “The examiner bears the initial burden of *factually supporting* any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the

applicant is under no obligation to submit evidence of nonobviousness” (emphasis added). As the Non-Final Action failed to provide any factual support for its conclusion that one of ordinary skill in the art would have been motivated to combine Shahoian with Moran, Applicant was, and is, under no obligation to provide any evidence of nonobviousness. The burden remained, and still remains, with the examiner to factually support the conclusion of nonobviousness. The Final Action failed to satisfy this burden.

As the Examiner has failed to make out a prima facie case of obviousness with respect to claim 1, Applicant requests reconsideration and withdrawal of the § 103 rejection of claim 1. Claims 2, 3, 5–18, 22, 23, and 32 depend from independent claim 1 and add further limitations thereto. Thus, Applicant requests reconsideration and withdrawal of the §103 rejections of these claims, too.

Additionally, specifically with respect to dependent claim 22, the Final Action fails to address Applicant’s remarks in Applicant’s Response. Claim 22 recites “a command for controlling a transparency characteristic of a document presented on the display.” As specifically indicated in Applicant’s Response, neither Shahoian nor Moran describe such a command. See Page 7. The passage in the prior art relied upon to reject the claim, i.e., column 8, lines 10–13, of Moran, (see Non Final Action at pages 9–10 and Final Action at page 10) describes a transparent drawing surface, not a command to change the transparency of a document presented on a display, as recited in the claim. See Page 7 of Applicant’s Response. Even considering an examiner’s obligation to interpret claim language as broadly as reasonably possible, no reasonable interpretation of claim 22 would equate a command to change a transparency of displayed document to a transparent surface. Thus, Applicant requests reconsideration and withdrawal of the §103 rejection of claim 22, on these grounds, as well.

Applicant believes no fee is due with this request other than as reflected on the attached Fee Transmittal. However, if a fee is due, please charge our Deposit Account No. 18-1945, under Order No. PGLD-P01-003 from which the undersigned is authorized to draw.

Dated: June 13, 2006

Respectfully submitted,

By 

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Registration No.: 54,130

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